

Application Serial No. 10/501,064

OT-4995

REMARKS

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-11 were pending in the application and were rejected in the Office Action. By way of this Amendment, Applicant has: (a) amended claims 1-4 and 9-11; (b) canceled 5-8 without prejudice or disclaimer; and (c) added new claims 14 and 15. Therefore, claims 1-4, 9-11, 14, and 15 are pending for further consideration.

1. Rejection of Claims 1-4 under 35 U.S.C. § 101

The Examiner rejected claims 1-4 under the new guidelines being applied to method claims under 35 U.S.C. § 101. Specifically, the Examiner states: "Independent claim 1 is non-statutory because the claim is directed to a method which does not produce a tangible result." For at least the following reasons, Applicant respectfully traverses this rejection.

As set forth in the M.P.E.P.: "While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, **methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be [patentable].**" See M.P.E.P. § 2106(IV)(C) (bold emphasis added). Further, a "claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it: . . . (B) otherwise produces a useful, concrete and tangible result[.]" See M.P.E.P. § 2106(IV)(C)(2). Finally, the M.P.E.P. provides some guidance as to what constitutes a "tangible result" by stating: "The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that **the process claim must set forth a practical application of that judicial exception to produce a real-world result.**" M.P.E.P. § 2106(IV)(C)(2)(b) (bold emphasis added).

In the case of claim 1 of the instant application, the claim recites a "real-world result" by reciting: "determining the functionability when the measured value is within a specific tolerance range." In so reciting, claim 1 recites a step in which the functionability of the lining is determined; ascertaining the state of the brake lining is clearly a real-world result in that it is directly related to knowing when to replace the lining. In light of the foregoing, a withdrawal of the rejection of claims 1-4 under 35 U.S.C. § 101 is respectfully requested.

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2. Rejection of Claims 1-11 under 35 U.S.C. § 102

The Examiner again rejected claims 1-11 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,384,721 ("Paielli"). Preliminarily, this rejection is now moot with respect to claims 5-8, which have been canceled herein without prejudice or disclaimer. Accordingly and for at least the following reasons, Applicant respectfully traverses this rejection with respect to claims 1-4 and 9-11.

A. Claims 1-4 and 9

As amended herein, claim 1 (*i.e.*, the claim from which claims 2-4 depend) recites a method of monitoring the functionability of a brake lining. This method includes, among other possible steps (*italic emphasis added*):

measuring a value that characterizes the dielectric constant of the lining, wherein the lining is provided between a first, pressing braking member and a second, pressed braking member;
comparing the measured value with a reference value for the lining;
and
determining the functionability when the measured value is within a specific tolerance range,
wherein, when the brake is actuated, the lining contacts the first, pressing braking member and the second, pressed braking member.

Similarly, claim 9, as amended, recites a brake that includes, among other possible things (*italic emphasis added*):

a first, pressing braking member;
a second, pressed braking member
a brake lining provided between the first and second braking members, the brake lining comprising a brake lining material; and
a brake lining monitoring device which is constructed so that it can determine the functionability of the brake lining on the basis of a change in the dielectric constant of the brake lining material,
wherein, when the brake is actuated, the lining is configured to contact the first, pressing braking member and the second, pressed braking member.

As hereafter explained, Paielli fails to teach or suggest at least the above-italicized limitations of the method recited in claim 1 and the brake recited in claim 9.

Claims 1 and 9 recite a lining that: (a) is provided between a first, pressing braking member and a second, pressed braking member; and (b) contacts (or is configured to contact) the first, pressing braking member and the second, pressed braking member, when the brake is actuated. Even assuming, *arguendo*, that Paielli implicitly teaches a non-shown pressing member such as a brake caliper (as discussed in the "Response to Arguments" section of the Office Action) such that the brake pad 42 could be analogized to the lining recited in claims 1 and 9, it is respectfully noted that such a lining (brake pad 24) would not be in contact with

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the pressing member (brake caliper) when the brake is actuated. As a result, Paielli fails to teach or suggest at least the above-italicized limitations of claims 1 and 9. Accordingly, Paielli can not be used to reject claims 1 and 9, or any claim dependent thereon, under 35 U.S.C. § 102(e). Moreover, as claims 2-4 depend from claim 1, each of these dependent claims is also allowable over Paielli, without regard to the other patentable limitations recited therein. Therefore, a withdrawal of the rejection of claims 1-4 and 9 under 35 U.S.C. § 102(e) for anticipation by Paielli is both warranted and earnestly solicited.

B. Claims 10 and 11

As amended herein, claim 10 (*i.e.*, the claim from which claim 11 depends) recites a brake that includes, among other possible things (*italic emphasis added*):

a brake lining comprising:

a lining; and

at least two conductors arranged in the lining in a way so that the conductors can be used to perform a capacitance measurement; and

a brake lining monitoring device which is constructed so that it can determine the functionality of the brake lining on the basis of a change in the dielectric constant of the brake lining,

wherein the lining is configured to be provided between a first, pressing braking member and a second, pressed braking member, *wherein the lining includes a braking surface, and wherein the conductors are arranged in a plane that is substantially parallel to the braking surface of the lining.*

As hereafter explained, Paielli fails to teach or suggest at least the above-italicized limitations of the brake recited in claim 10.

As above-italicized, claim 10 recites "at least two conductors . . . [that] are arranged in a plane that is substantially parallel to the braking surface of the brake lining." In contrast, Paielli teaches conductors, clearly shown in Fig. 1, that are substantially perpendicular to the braking surface. Accordingly, Paielli can not be used to reject claim 10, or any claim dependent thereon, under 35 U.S.C. § 102(e). Moreover, as claim 11 depends from claim 10, claim 11 is also allowable over Paielli, without regard to the other patentable limitations recited therein. Therefore, a withdrawal of the rejection of claims 10-11 under 35 U.S.C. § 102(e) for anticipation by Paielli is both warranted and earnestly solicited.

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3. New Claims 14 and 15

New claims 14 and 15 respectfully depend from claims 1 and 9 and are, therefore, allowable for at least the same reasons as claims 1 and 9 and without regard to the other patentable limitations recited therein.

CONCLUSION

In light of the foregoing, claims 1-4, 9-11, 14, and 15 are in condition for allowance. If the Examiner believes that a telephone conference will be useful to move this case forward toward issue, Applicant's representative will be happy to discuss any issues regarding this application and can be contacted at the telephone number indicated below.

Respectfully submitted,

Date: April 18, 2007**Customer Number: 26584**

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